

REMARKS

Reconsideration is respectfully requested in view of the remarks made herein. Claims 1, and 4-19 are pending and stand rejected. Claims 1 and 19 are independent claims and have been amended. No new matter has been added. Support for these amendments can at least be found in the published specification in paragraph [0092].

Pending claims stand rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. In particular, the examiner argues that “[t]he term ‘substantially’ renders the claims indefinite as it is unclear whether the limitation is accomplished or not” (Final Office Action, para. 3). The Advisory Action also states “it is necessary to provide a clear indication of how the limitation is fully implemented” (page 2, last paragraph).

Applicant respectfully disagrees. It is well settled that the use of the term “substantially” does not per se render a claim indefinite. By way of example, the Court of Appeals for the Federal Circuit (CAFC) recently held, in Verve, LLC v. Crane Cams, Inc., 311 F.3d 1116 (2002) that such language is permissible when warranted by the nature of the invention:

It is well established that when the term "substantially" serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art, it is not indefinite. Understanding of this scope may be derived from extrinsic evidence without rendering the claim invalid.

The CAFC found that the lower court erred in requiring that the intrinsic evidence of the specification and prosecution history is the sole source of meaning of words that are used in a technologic context. The CAFC stated that determination of the meaning of such words is that as would be understood by persons in the field of the invention. In other words, an applicant need not explicitly state in the body of the patent application that the terms "substantially" or "about" mean plus, or minus, so many units.

The current invention relates to a structure wherein at least two types of particles having different colors are used. In an embodiment of the invention illustrated in Fig. 3 and described in paragraph [0092] of the published application [emphasis added]:

the red particles 6 are in substantially separate region 20 near the surface 110 of electrode 10, and the green particles 7 are in substantially separate region 21 near the surface 111 of electrode 11, **whereas substantially no particles 6,7 are in substantially separate region 25.** The electrodes 10,11,15 have respective potentials of e.g. 10 Volts, 10 Volts and 0 Volts.

In the interests of furthering prosecution, both independent claims 1 and 19 have been amended to define a substantially empty sub-region as being a sub-region that “is substantially empty of both the first and second charged particles.” As described in paragraph [0092] of the specification, this emptiness is created by simply applying appropriate voltages to the sub-region electrodes.

Consequently, applicant submits that the claim feature “substantially empty of both the first and second charged particles” would be understood by persons in the field

of the invention (referencing the criterion cited in the CAFC Verve, LLC v. Crane Cams, Inc. opinion above). Further, the specification describes how establishing a sub-region that is substantially empty, so defined, can be readily implemented and can be accomplished without trial and error (referencing the criteria cited by the examiner in the last paragraph on page 2 of the Advisory Action).

With the above noted explanation and the amendments to the claims, applicant submits that the reason for the examiner's rejection under 35 USC 112, second paragraph, has been overcome and that claims 1 and 4-19 are allowable.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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